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Supreme Court of the United States

OCTOBER TERM, 1951

No. 144

JOHN G. KURZEN, JR.

Petitioner

v.

JOHN A. MARZALL, Commissioner of Patents

Petition for Writ of Certiorari to the United States Court of Appeals for the District of Columbia

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JOHN A. MARZALL, Commissioner of Patents

Petition for Writ of Certiorari to the United States Court of Appeals for the District of Columbia

MAY IT PLEASE THE COURT:

Petitioner prays that a writ of certiorari issue to review the judgment entered in this case on March 29, 1951 by the United States Court of Appeals for the District of Columbia. [55][1]

Opinion Below

The district court wrote a brief opinion. [8] The opinion of the court of appeals appears in the record. [54] It is not yet reported.

Jurisdiction

The judgment of the court of appeals was entered on March 29, 1951. [55] The jurisdiction of this Court is in-

[1] Figures in brackets refer to pages of the printed record.

voked under Chapter 646 of the Act of June 25, 1948; 62 Stat. 928, 28 U. S. C. 1254.

Questions Presented

ONE

Is the petitioner entitled to a design patent on a portable phonograph which presents a departure from all prior designs, the appearance of which attracts attention in a new and ornamental manner promoting progress and science and useful arts within the meaning of Section 8, Article I of the United States Constitution and the laws of Congress?

TWO

May the patent office and the courts below disintegrate prior patents and from them mentally reconstruct a new device so as to anticipate petitioner's design and deny him his rights under Section 8, Article I of the United States Constitution and the laws of Congress?

Statute Involved

The courts below were called upon to construe and apply Sections 4929 and 4933 of the Revised Statutes as amended, being 35 U. S. C. 73. It reads as follows:

"§73. Patents for designs; how obtained; regulations applicable

"Any person who has invented any new, original, and ornamental design for an article of manufacture, not known or used by others in this country before his invention thereof, and not patented or described in any printed publication in this or any foreign country before his invention thereof, or more than one year prior to his application, and not in public use or on sale in this country for more than one year prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law and other due proceedings had, the

same as in cases of inventions or discoveries covered by section 31 of this title, obtain a patent therefor.

"All the regulations and provisions which apply to obtaining or protecting patents for inventions or discoveries not inconsistent with the provisions of this title, shall apply to patents for designs."

Statement

Petitioner duly filed in the time and manner required by law an application for patent. It appears in the patent office files. It was received into evidence. [37-51] The original exhibits have been sent up to this Court. [10]

The application covered a diminutive, shoulder-strap, portable phonograph, the size of a lady's purse, which was demonstrated to the trial court by witnesses who testified for the petitioner. The object covered by the design under application D-120,153 was described as square, thin, being one-fourth as thick as it is high and wide, having two grilles for the emission of sound. The design was said to describe "a midget phonograph. It is not a big one like the usual horizontal type." [11] The design shows an upright, portable phonograph different from all other phonographs, being midget in size and operating in vertical position. [11] The design is different from the usually broad portable phonographs that operate in a horizontal position. [11] The design shows the midget, vertical phonograph suspended from the shoulder by a strap similar to that of a lady's shoulder purse or bag. [12]

The witness showed that the Motorola automobile radio relied on by the Patent Office had no similarity, it being a housing box for the electrical equipment of the automobile radio. The witness showed that no similarity existed between the Motorola box and the portable phonograph. [13-14] The witness showed that there was no similarity between the grillwork in the small vertical phonograph and the grillwork of the huge General Electric transmitter relied

on by the Patent Office. [14-15] The witness showed that the design described a small phonograph easily adaptable to carrying on the person like a woman's purse. [15] The witness showed that there was no portable phonograph that had a similar appearance to that shown in the design. [15-16] The witness explained that there would be considerable difficulty experienced if the rounded curves and the grillwork of the various devices referred to by the Patent Office were substituted for that of the design in question. [17-19]

A radio engineer showed that petitioner's design had no similarity to that of the five references made by the Patent Office in the denial of the Kurzen application. [21-29] It was shown that there was no similarity between the Philco radio-phonograph and the Kurzen design. [22] The grillwork of the Philco design "is to my mind much different and doesn't resemble the opening". [22] "The two openings on the Kurzen device have more of a rectangular effect although there is no straight line involved where the Philco has the effect of the appearance of an oval". [23] The Motorola device was distinguished in appearance by the witness from the Kurzen design. "It would be stretching the imagination to say that we would look at the Motorola and then go and design another case with different radiuses and say anyone that would come along and say that it resembles it or that we copied from it." [23-24] The Harrison Wholesale Co. device was distinguished and shown to have no similarity. [24-25] The General Electric transmitter design relied on by the patent office was shown to be clearly dissimilar to the Kurzen design. "The resemblance between the General Electric transmitter and the Kurzen device is not apparent at all because here we have, again, a louvre effect with many lines on it, and the lines themselves run all the way across the louvre, with the appearance of a rectangular opening with square corners in the opening. If a design patent was given on this General Electric trans-

mitter it would not be because of the presence or absence of those louvres but on the general appearance to the eye, and which in this case is much different than the Kurzen device." [26]

Concerning all of the references made by the Patent Office in the denial of the Kurzen application it was said, "I don't see how anyone could mistake the Kurzen device for any of these, or even the combined effect of all of them put together." [26] Petitioner was shown to have produced a device that gives a new impression to the eye when considering it as a whole from all other devices known to the electrical and sound-reproducing field. [26-28]

Following the denial of the application for patent, an action was instituted by petitioner in the district court under 35 U. S. C. 63, no appeal being filed in the United States Court of Customs and Patent Appeals. [2-3]

The respondent answered admitting the jurisdiction of the court to entertain the action. [3-4] The action was brought to obtain a patent on a design for a portable phonograph. [2-3] The district court heard evidence and dismissed the civil action at the cost of petitioner. [5-6] The court found that the design covered by the application for patent did not involve "anything which in the eye of the ordinary observer would produce a different effect from anything that has preceded it". [8] He found that the references cited by the Patent Office disclosed that the design had been anticipated by the prior art. [8] He concluded that the design "manifests nothing in the nature of invention". [8] The court found that petitioner filed his application for design patent No. 120,153 on the portable phonograph. He described the design for the portable phonograph cabinet as "comprising a box, essentially square in conformation but having a thickness substantially less than the other dimensions. The casing is provided with rounded corners, two side-by-side grilles near the top of one of the larger faces, and a handle folded into one of the edges." [6]

The court found that the large portable radio cabinet of the Harrison Wholesale Co. cited by the Patent Office had "a substantially square outline and a thickness less than its other dimensions. It is provided with slightly rounded corners and a pair of side-by-side grilles on the upper part of one of the cabinet faces." [6] The court found that the Philco portable phonograph cabinet was "provided with a grille having a rounded outline and three cross bars formed of the material of the cabinet." [6] The court found that the Motorola automobile radio "comprises a box of rectangular outline and reduced thickness with rounded corners." [7] The court found that the British portable phonograph cabinet had "a handle m adapted to fold into the side of the cabinet about hinge m'". [7] The court found that by combining the above cited citations in the different objects covered by the prior art the design of petitioner was anticipated and did not involve invention. [7] The court concluded that separate references from different objects may be combined in rejecting a claim for a design patent and that a new and utilitarian function did not contribute to the patentability of petitioner's design. [7-8]

The petitioner duly appealed to the court of appeals. [8-9] The court of appeals held:

"The application involved in this proceeding discloses a design for a phonograph cabinet comprising a box, essentially square in conformation but having a thickness substantially less than other dimensions. The casing is provided with rounded corners, two side-by-side grills near the top of one of the larger faces, and a handle folded into one of the edges. Each one of these features is contained in a prior patent.

"We feel the lower court was quite correct when it held that 'A number of references may be used to rejecting a claim to a design if each of the features is old and no invention is involved in combining them.' Therefore, the judgment of the District Court is *Affirmed.*"

Specification of Errors

The Court of Appeals erred:

(1) in deciding that the design invention of the portable phonograph did not involve such inventive talent as the statute required.

(2) in considering as prior art certain earlier patents embodying unintegrated elements of petitioner's design.

(3) in concluding that petitioner's patent was invalid for lack of invention.

(4) in finding anticipation by picking out parts of other totally different devices of other classes of design and mentally integrating and reconstructing them into a design like that described in petitioner's application for patent.

Reasons for Granting the Writ

The decision of the court of appeals strikes dead the spirit and perverts the intention of Congress expressed in Section 73 of Title 35 of the United States Code. It has allowed the patent office to reach into fields outside the limited class relating to a particular design, cull from here and there portions of other designs and reconstruct them by a "scissors and paste-pot" method to justify the denial of a meritorious application for design patent.

The court of appeals has announced a doctrine which authorizes the patent office to water down and completely emasculate Section 73, Title 35 of the United States Code.

It is for Congress to repeal the design patent statute rather than allow the patent office to drain the blood out of the body of the statute and produce its slow but certain demise. The design patent statute is dead, having been unlawfully given the *coup de grace* by the patent office with the imprimatur of the courts below.

I

The decision of the court below is in conflict with the holdings of other courts of appeals. *Naylor et al.* v. *Alsop Process Co.*, 168 F. 911, 920 (C. A. 8); *Wisconsin-Minnesota Gas & Electric Household Appliance Co.* v. *Hirschy Co.*, 28 F. 2d 838, 841 (C. A. 8); *J. A. Mohr & Son* v. *Alliance Securities Co.*, 14 F. 2d 799, 800 (C. A. 9); *Mygatt et al.* v. *Schaffer*, 210 F. 827, 830-831 (C. A. 2).

II

The decision of the court below is in conflict with the holdings of this Court in *Gorham Mfg. Co.* v. *White*, 14 Wall. 511, 525; *Knapp et al.* v. *Morss*, 150 U. S. 221, 228; *Miller, et al.* v. *Eagle Mfg. Co.*, 151 U. S. 186, 203.

III

An important question is involved that has been decided by the court of appeals, which ought to be decided by this Court, affecting the interests of the public and the design patent law. This case presents exceptional circumstances that are sufficient to constrain this Court to grant the petition for writ of certiorari. It is important for the people to be definitely and finally told whether the design patent law is dead or alive.

Discussion

Until the aberration of the court below it has been the patent law of the land that design patents could not be refused by the use of a pair of scissors and a paste pot to reproduce from other designs an imaginary design which anticipates a new and inventive real design.

Thus, in *Mygatt, et al.* v. *Schaffer*, 210 F. 827, the Court of Appeals for the Second Circuit said:

"In *Washbourne & Dunn* v. *Webster*, 195 Fed 522, 115 C. C. A. 432 (1912), each element of the patented design considered separately was old, and sometimes two or more of

them appeared combined in the prior art, and yet we held that these facts did not invalidate the patents, unless it appeared that they were so assembled as to form the designs of the patents then in suit. And we then stated that it was the design as a whole which had to be considered; that the situation in this respect was analogous to machines made up of old elements. It sufficed that the machine produced a new result, or the design a new impression upon the eye. It is the design of the whole thing that it appears in use which is the test in cases of the class in suit." 210 F. at pp. 830-831.

Also a combination of references into a new imaginary device was rejected in *Naylor et al.* v. *Alsop Process Co.*, 168 F. 911. The Court of Appeals of the Eighth Circuit said: "When it is sought to ascertain the state of the art by means of prior patents, nothing can be used except what is disclosed on the fact of those patents. Such patents cannot be re-constructed in the light of the invention in suit, and then be used as a part of the prior art." (168 F. at p. 920) Similarly, in *J. A. Mohr & Son* v. *Alliance Securities Co.*, 14 F. 2d 799, 800, the Court of Appeals for the Ninth Circuit states the same doctrine.

In *Wisconsin-Minnesota Gas & Electric Household Appliance Co.* v. *Hirschy Co.*, 28 F. 2d 838, 841, the Court of Appeals for the Eighth Circuit stated: "This practice of building up anticipation by changing and combining parts of structures of prior patents cannot be indulged."

Petitioner's new and ornamental design for a portable phonograph presents a departure from all prior designs. It is small. The case stands vertical. It is of equal width and height. The corners are well rounded with a large raduis. It is "thin", that is its depth or thickness (from front to rear) is one-fourth of its height. On its front face, are two identical matched grilles, adjacent each other, both above the center line of the face, in balanced relation. The contour of each grille simulates the contour of the case. Each grille

is of equal width and height. The corners are well rounded with a large radius. The louvres relieve the impression of the grilles. The handle lies closely contiguous the case, in unobtrusive fashion.

The artist has thus produced a design for a phonograph that is as elegant as it is simple, as unique as it is novel.

A patent for this design has been refused on a so-called combination of cited catalogue pages from different manufacturers and a British patent. Mere inspection shows that not a single one of the citations is suggestive of appellent's design, not even remotely so. So, to synthesize a rejection, isolated elements have been taken at will here and there from the unrelated flat phonographs, vertical radios, and at times even gigantic radio-frequency transmitters, and these unrelated, isolated elements have been synthesized into an imaginary structure, impossible to visualize, as a basis for a refusal of a patent.

Petitioner under the law is entitled to a patent where the Patent Office seeks to build up a hypothetical structure from a number of citations, not a single one of which gives the visual impression on the casual observer that results from appellant's design.

While petitioner's application for a design patent was in course of consideration by the Patent Office, a change in established standards for design patents was made by a new office head. The new policy was that design patent protection should not apply to more common articles of manufacture. Such extreme views, found incongruous, have recently been relaxed by later office management. But before the illegal policy was corrected the petitioner has been refused his patent. The discriminatory result to petitioner by the reversal of the Patent Office policy leads us to the necessity of seeking a remedy in this Court.

It is of interest relative to the present case that the temporary departure from the long-practiced standards in the Patent Office has been relaxed, but too late to help pe-

titioner; and note may be made of some random simple designs for common articles of utilitarian manufacture recently issued:

Suitcase or Satchel No. D-159,128
Television Cabinet No. D-159,161
Automobile Bumper No. D-159,230
Cutting Shears No. D-159,231
Carpenter's Plane No. D-159,339

The discrimination inadvertently worked on petitioner during the period of repeal is manifest, and in equity calls for correction by this Court.

The design in question gives a distinctive appearance to the new midget portable phonograph. It enhances its appearance and attracts attention to the design of a new thing in the field of portable phonographs.

The purpose of Revised Statute 4929 is to provide a patent for a new and ornamental design for articles of manufacture not used or made before. The law encourages new design of articles of manufacture. The Design-patent Law covers ordinary articles of manufacture. The law is distinguished from the Copyright Law which protects the fine arts. The law should be liberally construed and design patents should be looked upon with greater leniency than other patents because the design patent is limited and does not occupy a great zone in the field.

While the Copyright Law operates in the domain of the fine arts, the Design-patent Law provides for the more lowly field of designs for articles of manufacture. As stated by the Supreme Court in the leading case *Gorham Mfg. Co.* v. *White,* 14 Wall. (81 U. S.) 511, 525,

> "And the thing invented or produced, for which a patent is given, is that which gives a peculiar or distinctive appearance to the manufacture or article to which it may be applied or to which it gives form. The law manifestly contemplates that giving certain new

> and original appearances to a patented article may enhance its salable value, may enlarge the demand for it, and may be a meritorious service to the public. . . . It is the appearance itself which attracts attention and calls out favor or dislike. . . . The appearance may be the result of peculiarity of configuration, or of ornament alone, or both conjointly, but in whatever way produced, it is the new thing or product which the law regards."

The purpose of the law is to encourage the patenting of new designs for articles of manufacture. Revised Stat. 4929 provides:

> "Any person who has invented any new, original, and ornamental design *for an article of manufacture,* not known or used by others in this country before his invention thereof, . . . may . . . obtain a patent therefor," R. S. 4929 (Italics added).

In contradiction from works of the fine arts, which are provided for in the Copyright Law, the Design-patent Law deals with ordinary articles of manufacture. As was pointed out by the court in *Dominick and Haff* v. *R. Wallace & Sons Mfg. Co.,* 209 F. 223, 224 (C. A. 2);

> "A design patent necessarily must relate to subject matter comparatively trivial and the courts have looked with greater leniency upon design patents than for other inventions."

In *Rousso* v. *Boyle,* 2 F. 2d 299, 300, it was stated: (D. C. Minn.)

> "It may be said that all this is very simple. This does not exclude invention, nor the patentability of the design. In this connection all that can or need be said is that throughout a long line of decisions, beginning with *Gorham* v. *White,* 14 Wall. 511, 20 L. Ed. 731, de-

sign patents covering designs quite as simple as this have been upheld."

Whether there is an anticipation of the design of the petitioner is to be determined by its appearance to the eye of the ordinary observer. The design as a whole must be considered. As long as it involves invention it is patentable.

Previously patented designs relied upon by the Patent Office must be limited to only what they teach. The various and different design patents referred to by the Patent Office may not be recombined, reconstructed and redesigned mentally to destroy petitioner's design. The Patent Office is not permitted to pick out elements from various structures and arbitrarily make up a new combination imaginary design to anticipate petitioner's design.

Conclusion

The application and claims presented by the petitioner to the patent office show the novel, useful invention of a design which was not anticipated by prior art. The design should have been patented. Petitioner has no recourse under the Copyright Law or any other law save and except under Section 73 of Title 35 of the United States Code. He should not be pushed beyond the reach of the protection Congress intended to give him in the absence of a repeal of the statute by Congress.

For the reasons stated herein, this petition for writ of certiorari should be granted.

Respectfully submitted,

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Counsel for Petitioner

June, 1951.

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In the Supreme Court of the United States

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No. 144

JOHN G. KURZEN, JR., PETITIONER

v.

JOHN A. MARZALL, COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

BRIEF FOR THE RESPONDENT IN OPPOSITION

OPINION BELOW

The District Court's brief memorandum opinion (R. 8) is unreported. The Court of Appeals affirmed in a *per curiam* opinion (R. 54), which is reported at 188 F. 2d 673.

JURISDICTION

The judgment of the Court of Appeals was filed on March 29, 1951 (R. 55). The petition for a writ of certiorari was filed on June 25, 1951. The juris-

diction of this Court is invoked under 24 U.S.C. § 1254(1).

QUESTION PRESENTED

The sole question presented is whether petitioner's design for a certain box or casing for a phonograph exhibits sufficient invention to entitle petitioner to a design patent.

STATUTES INVOLVED

The pertinent provisions of R.S. 4929, 35 U.S.C. 73, relating to design patents, are as follows:

> Any person who has invented any new, original, and ornamental design for an article of manufacture * * * may, upon payment of the fees required by law and other due proceedings had, the same as in cases of inventions or discoveries covered by section forty-eight hundred and eighty-six, obtain a patent therefor.

STATEMENT

Petitioner applied for a design patent on a casing or cabinet, used for housing a portable phonograph. The casing is described as "essentially square in conformation but having a thickness substantially less than the other dimensions. The casing is provided with rounded corners, two side-by-side grilles near the top of one of the larger faces, and a handle folded into one of the edges" (R. 6). A sketch of this box appears at page 46 of the Record. A Patent Office examiner recommended rejection of the application for want of

invention. The Patent Office Board of Appeals affirmed the action of the examiner and the Commissioner rejected the application. Petitioner then brought suit in the District Court, pursuant to R.S. 4915, 35 U.S.C. 63, to compel the Commissioner to issue the patent. The District Court, after hearing evidence, held the design unpatentable and dismissed the suit. Petitioner appealed to the Court of Appeals. The Court of Appeals rejected his contentions and affirmed the judgment of dismissal.

The holding by the District Court of lack of invention was based on anticipation in the prior art. Evidence of the prior art took the form, among other things, of pictures in various electrical equipment catalogues, one of which was a portable radio case, manufactured by the Harrison Wholesale Co., of rectilinear shape, thin in one dimension, and having two grilles in one of the large faces (R. 43); a radio, manufactured by Motorola, having a rectilinear case with rounded corners and edges (R. 45); and a radio, manufactured by Philco, having a rounded grille (R. 44). The Commissioner contended and the District Court agreed that the general form of the Harrison model, modified by the Motorola rounded edges and the Philco rounded grille form, anticipated the essentials of petitioner's design.

The District Court also found, as a fact, that the handle feature of plaintiff's design was simply a utilitarian feature, dictated by the mechanical re-

quirements, and hence adding nothing to the patentability of the design (R. 7). It also found that the handle feature had been anticipated in the prior art by a certain English patent (R. 7) and that, even in the absence of references to prior art, the expedient of rounding corners of cabinets was well-known (R. 7). The District Court thus held that petitioner's design lacked invention.

Petitioner based his appeal to the Court of Appeals chiefly on the contention that it was erroneous for the District Court to permit the combination of references in showing the state of the prior art. The Court of Appeals rejected this contention and affirmed the judgment of the District Court, dismissing the complaint.

ARGUMENT

The statutory test for the validity of a design patent, like that for a so-called mechanical patent, includes the requirement that the design exhibit invention. See *e.g., Smith* v. *Whitman Saddle Co.,* 148 U.S. 674, 679; *Application of Johnson,* 175 F. 2d 791 (C.C.P.A.). Petitioner asks this Court to override the unanimous agreement among two tribunals of the Patent Office and the two courts below that his box exhibits nothing in the way of invention that an ordinary designer, skilled in the art, could not have readily devised. We submit that the tribunals below were obviously correct.

Even aside from the particular examples of the prior art cited by the Commissioner, it is apparent

that petitioner's design includes little more than the rudimentary requirements of any electrical equipment housing. A phonograph needs a cabinet. Petitioner has built a box, rounding its edges. A phonograph cabinet needs a grille for the emission of sound. Petitioner has given it two grilles, rounding their corners and covering them with louvers. A mechanically wound phonograph needs a winding handle. Petitioner has equipped his box with a handle.

In other words, petitioner was faced with the engineering problem of housing a small portable phonograph. His solution, except for the expedient of rounding some edges and corners and choosing a particular grille, is the obvious and necessary response to the engineering exigencies. It is clear that a design for a manufactured article which is evoked as a necessary response to the engineering requirements of the article is not patentable as a design. See, *e.g., Hueter* v. *Compco Corp.,* 179 F. 2d 416 (C. A. 7); *Circle S Products Co.* v. *Powell Products,* 174 F. 2d 562 (C. A. 7); *Applied Arts Corp.* v. *Grand Rapids Metalcraft Corp.,* 67 F. 2d 428 (C. A. 6). Whether petitioner may have some basis for a mechanical patent on his method of encasing a phonograph in a small space is, of course, not material to the present case.

Beyond the minimum engineering exigencies, petitioner has rounded the edges of his box and the corners of its grilles. But one does not need

the District Court's finding that the expedient of rounding edges is old in the prior art (R. 7), to perceive that this expedient is not inventive. Indeed, this is the sort of thing that is likely to be found sketched in the margins of the copybooks of any mechanically-inclined schoolboy. Moreover, if invention is to be attributed to petitioner's rounded corners and double grilles, then it seems inescapable that every variation in the amount of curvature or in the number of grilles or the number of their louvers is equally inventive, which is absurd. It is often stated that obvious changes in arrangement and proportioning are not patentable. *E.g., Application of Stevens,* 173 F. 2d 1015 (C. C. P. A.).

So regarded, petitioner's design is unpatentable even without reference to the prior art; and since the question of invention here involved amounts to a question of the application of the statutory standard of invention to the facts of the case—clearly a question of law, see *A. & P. Tea Co.* v. *Supermarket Corp.,* 340 U. S. 147, 153-154, 156—it follows that evidence of the prior art is not prerequisite to a holding of lack of invention.

Nevertheless, such evidence was, as might be expected, abundant. The Commissioner relied particularly on the so-called Harrison Wholesale Co. catalogue reference (R. 43) as showing a portable radio case of rectilinear shape and having two grilles in one of the large faces; on a so-called Motorola radio (R. 45) as showing a rectilinear

case with rounded edges; and on a certain Philco radio model (R. 44) as showing the rounded form of grille. These three elements, all in the radio cabinet field, anticipate all the essentials of petitioner's design.

Petitioner attempts to attribute to the present case a significance broader than that of a decision on its particular facts, by arguing that the decision of the Court of Appeals was contrary to holdings of other circuits. He contends that a rule can be drawn from the cases to the effect that it is never proper for the Commissioner to base a decision of lack of invention or of anticipation in the prior art on the ground that various parts of the patent in suit existed separately in the prior art. No such conflict and no such rule exist.

There is no rule preventing the Commissioner from combining references, in appropriate cases, to show anticipation or lack of invention. This Court recently rejected just such a rule, in respect to mechanical patents, in *A. & P. Tea Co.* v. *Supermarket Corp.*, 340 U. S. 147. An analogous rejection should be applied in the case of design patents. The question, under the statute, is whether the given combination of previously known parts constitutes an inventive advance over the prior art, and obviously this question does not permit an answer based on rules formulated in advance. Many cases appear in the reports in which design patents have been denied or held

invalid on the ground that their component parts appear separately in the prior art. Among these cases are some cited by petitioner in support of his alleged rule. *E.g., Knapp* v. *Morss,* 150 U.S. 221 (mechanical patent for dress form); cf. *In re Faustmann,* 155 F. 2d 388 (C. C. P. A.) (design patent for typewriter keys and space bar); *Howell Co.* v. *Royal Metal Mfg. Co.,* 93 F. 2d 112 (C. A. 7) (design patent for metal two-piece chair frame).

Most of the cases holding that combinations of references do not invalidate the patent are cases in which either each of the combined parts has been substantially modified before being combined, *e.g., Application of Jennings,* 182 F. 2d 207 (C. C. P. A.), or else cases involving such designs as silverware or china patterns, where the number of combined parts is so multifarious as to allow room for artistic invention in the combination, *e.g., Graff, Washbourne & Dunn* v. *Webster,* 195 Fed. 522 (C.A. 2). The present case is of neither such type.

Petitioner contends that the Patent Office has discriminated against his application because of a change in Patent Office policy as to patentability. Nothing of any such change in policy appears in the record, nor does it appear that the alleged change in administrative policy was applied in a discriminatory manner rather than uniformly to all applicants while it was in effect.

CONCLUSION

This case involves no issue of significance beyond its particular facts, and the decision below is clearly correct. It is respectfully submitted that the petition for a writ of certiorari should be denied.

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No. 144

[redacted]

JOHN C. KIRZER, JR.,

Petitioner

v.

JOHN A. MARSALL, Commissioner of Patents

[redacted]

ON PETITION FOR WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE DISTRICT OF COLUMBIA

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Reply to Brief in Opposition

[redacted]

Sol. Shapiro
Hayden C. Covington
Counsel for Petitioner

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1951

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Reply to Brief in Opposition

MAY IT PLEASE THE COURT:

The type of rejection involved here is of the gravest import to patent law. In all cases before this Court that come to mind, where a patent is invalidated over a combination of citations, there has always been a concept of the invention in the prior art. A single citation discloses

the essential concept, and subsidiary patents or other citations are then relied on to show substitution of details.

But that is not what is being done here. No prior citation shows petitioner's design. One need only make a visual comparison with Harrison or Motorola or Philco to see that they do not give the mental impressions that are obtained from petitioner's design. So that here, a design patent is refused not because it is shown in the citations, but because after petitioner's disclosures and teachings, it is then possible to take isolated elements from the prior art and reconstruct them into an entity that is the result of petitioner's teaching. Such mental gymnastics are not permissible as a basis for refusal of patents.

The situation in the present case is like that referred to by Judge Luhring of the District Court in *Hurd* v. *Coe, Commissioner of Patents,* 17 F. Supp. 312, 315 (D.C.D.C.), in which it was stated:

> "The Patent Office has built up a hypothetical structure from a number of patents, and points to this as anticipating the plaintiff's claim. This practice is not approved by the courts. *Economy Appliance Co.* v. *Fitzgerald Mfg. Co.,* 35 F (2) 756; *Detroit Motor Appliance Co.* v. *Burke,* 4 F (2) 118; *Naylor* v. *Alsop Process Co.* 168 Fed. 911."

Also in *Hartford-Empire Co.* v. *Coe, Commissioner of Patents,* 87 F. 2d 741, 744, the Court of Appeals stated:

> "We have had occasion in many instances to condemn the hindsight nunc pro tunc method employed to justify the refusal of valuable inventions in which the patentees are entitled to the protection afforded by the Constitution and the laws."

The practice followed in the Patent Office and in the

court below is of the gravest consequence because it sets up an arbitrary standard for refusal of a patent based not on what has been done in the prior art, but rather on what facile minds may make out of the prior art in the light of petitioner's own contribution. Petitioner is pilloried on his own invention—and not on what was known before him. If such practice is approved the entire fabric of patent protection is destroyed.

It has become a commonplace occurrence to apply the stigma of "utilitarian" to a design patent and on that basis urge its non-patentability. The argument runs like this. The article has utility. Any part of it contributes to the utility of the article as a whole. Therefore, any feature of the design involves a part of the article and is "utilitarian." The position is vicious and destroys the very patent act itself insofar as design patents are concerned.

By statute, the design must be applied to an article of manufacture. The fact that the article may itself have utility has utterly nothing to do with patentability of the design as a new and ornamental contribution. Thus the fact that a handle is present to wind the instrument has utterly nothing to do with whether the design as a whole is a patentable entity. Consider the box itself. It also has utility, since it is a container. But that does not defeat patentability of a design for the box. Design patents have been granted on every conceivable type of article of manufacture —from perfume containers to locomotive headlights, etc., etc. The utility of the article qua article is no legal basis for attack against patentability of the design as a design.

The dangerous character of the Patent Office position is well illustrated by the argument at the top of page five of the brief in opposition. It urges rejection of the design without considering the features of the design at all, basing its attack on the fact that the design is applied to an article which has utility. It would be just as fallacious

to argue that a design for a fork is unpatentable because it must have a handle and it must have tines.

The argument on page five, first paragraph, defeats itself. It is that the design was evoked as a necessary response to engineering requirements. Why then does respondent not find the design in the prior art? Why then does respondent have to synthesize petitioner's design from isolated, unrelated elements in prior art citations, not from the teaching in the art, but in the light of petitioner's contribution? The elements of petitioner's design qua design could have been made in a million different ways and the specious argument based on obvious and necessary engineering practice is merely a shroud to cover the obvious deficiencies of the art. More so, it goes to the vitality of the design patent law itself and bids fair to sap what remaining strength it possesses. It is strange indeed to see the Patent Office itself, whose very existence depends on a virile patent practice, undermining the very basis for such practice.

Petitioner has utterly no quarrel with the decision of this Court in *A. & P. Tea Co.* v. *Supermarket Corp.*, 340 U. S. 147, in the light of the facts of that case. But it has nothing whatsoever to do with the question of patentability of the design in the present case, unless indeed it is to show that the Patent Office is not infallible in its judgments, since it granted the patent which was held invalid in that case. But as certainly and correctly laid down in the *A. & P.* case, the fundamental question is whether the patentee has added to the sum of useful knowledge, or in the present design case, possibly we should say, has added anything to the sum of ornamental knowledge. And petitioner believes that the impression on the eye of the man in the street is so markedly different in the case of petitioner's design from that of any of the prior art as to require a holding of patentability.

The Patent Office position here has been destructive. It breaks the design down into individual elements, seeks out such elements in the prior art, and willy-nilly urges anticipation. That position avoids like the plague, the composite whole, the law of unification, the master's touch which runs through petitioner's contribution. Then brazenly respondent urges as law that all that is necessary (page eight) is to find separately appearing component parts in the prior art. There is no such acceptable law. In *Knapp* v. *Morss,* 150 U. S. 221, 227 this Court found that the elements of the Hall patent were all old in the art for the very same function and result. Exactly the same was true in *Howell* v. *Royal,* 93 F. 2d 112, where the elements of the chair of the design patent were old in combination. Again it may be noted that the Patent Office was in error in granting the patent in each of the cases cited. Its refusal in granting the patent here is just as erroneous and ill-considered.

Particularly is the rule as to permitted combinations of prior art references carefully applied where any of the elements must be modified before synthesis into the novel design. Yet this error is exhibited by the respondent. The latter takes each individual element from the prior art, modifies it, and then recombines in the light of petitioner's invention. Respondent cites the law against such practice.

In conclusion, it should be pointed out that there is a great deal more involved in the present case than whether Kurzen gets a patent. A pattern of refusal is being built by respondent that will plague the system of administration and jurisprudence for years to come and saddle the inventor with an incubus that defeats the very purpose of the Constitution and the Statutes in refusing the reward of a patent to him.

WHEREFORE petitioner prays as in his petition for writ of certiorari.

HAYDEN C. COVINGTON
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September, 1951.